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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,389	02/02/2000	Boris V. Marchegiani	11305/1	6138

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EXAMINER
COLBERT, ELLA

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)
Advisory Action	09/496,389 ⬤		MARCHEGIANI, BORIS V.
	Examiner		**Art Unit**
	Ella Colbert		3624 MW

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<u>PERIOD FOR REPLY</u> [check either a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
       NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet.*

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: *1, 4-6, 8-11, 15-17, 19-24, 26, 28, 29, and 35*.

    Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s) _____.

10. ☐ Other: _____.

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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PTOL-303 (Rev. 11-03)   Advisory Action   Part of Paper No. 12

Continuation of 5. does NOT place the application in condition for allowance because: The Applicant's Amendment B, filed 1/15/04, will not be entered because only minor informalities were amended in the Specification and there were no amendments presented in the claims to better define the claim language and Applicant's novel feature. The issues presented according to the Examiner's interpretation of Applicant's arguments are the following: Issue no. 1: Applicant argues: Applicant initially disputes the "final" status of this rejection and the Final Office Action asserts that the amendments to the claims made in the response to the prior Office Action of October 23, 2002 necessitated the new ground of rejection, it is submitted that this is not the case since all of the claim limitations in the amended claims were presented in the original claim set (either in an original independent claim or in an original dependent claim), and the Wiseman reference (while of record) was explicitly NOT relied upon in the first Office Action. Response: The Examiner has considered Applicant's argument but does not find the argument persuasive based on according to the Examiner's finding of Applicant's submitted claim amendments, the claim amendments of the Amendment A appear to be substantially amended requiring a new reference be used in the rejection. The following amendments appear in the application: Amendment A, filed 04/28/03, paper no. 8 and Amendment B, filed 01/15/04, not entered. Applicant is respectfully requested to point out in the claims/claim amendments which claims the amendments were taken from and which filed document of record. Issue no. 2: Applicant argues: It appears that with the benefit of further review of the claimed subject matter, the Examiner has elected to apply an additional reference due to the arguments (as opposed to the amendments) presented in the earlier response indicating why the Lindsey and Borgato references failed to render obvious this subject matter. In this regard, since the MPEP states that a rejection should not be considered final when a new ground of rejection is asserted that is not necessitated by Applicant's amendment to the claims (MPEP 706.07(a)), withdrawal of the finality of the obviousness rejection of claims 1, 4, 11, 17, 26, and 35 is therefore requested. Response: Applicant is respectfully referred above to the response to issue no. 1. Issue no. 3: Applicant Argues: In rejecting a claim under U.S.C. 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. Response: This argument is not considered persuasive based on the following case law: A suggestion/motivation need not be expressly stated in one of all of the references used to show obviousness. Cable Electric Products, Inc. v. Genmark, Inc., 770 F2d 1015, 1025, 226 USPQ 881 (Fed. Cir. 1985); In re Sheckler, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971). It is assumed that every reference relies to some extent on the knowledge of persons skilled in the art to complement that which is disclosed therein. Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. In re Bode, 550 F 2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); In re Jacoby, 309 F 2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference". In re Bozek, 416 F 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Also see MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART-RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT". Issue no. 4: Applicant Argues: It is submitted that neither the particular cited sections relied upon, nor the Wiseman reference as a whole, disclose "a processing device that enables a user to request an exception to create or modify a term of the at least one tender" and "the transaction does not consitute a tender in a multiparty auction environment and that therefore, the combination of Lindsey, Borgato and Wiseman fails to disclose or suggest each of the cited elements of claim 1. Response: It is interpreted that Lindsey teaches, a storage device storing data .... in col. 4, lines 5-12 (the bale was stored ... storage in the centralized data base ... each bale placed in a loan, or solded to the purchaser of the cotton bale (tender), Wiseman teaches, using currency (tender) for trading commodities and floppy disks for storage and tranferable media (col. 8, lines 42-47), and Borgato teaches, a host processor having a suitable data structure for storing and using money (tender) to buy the diamond (commodity) and the commodity (diamond) is multi-variable in price, weight anc other characteristics. Therefore, the Examiner interprets Wiseman, Lindsey, and Borgato as teaching the claim limitations of claim 1 .